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Inventors: Bennett et al.
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REMARKS

Claims 1-14 and 21-32 are pending in the instant application. Claim 3 has been canceled.

I. Restriction of the Sequences of Claim 3

The sequences listed in claim 3 have been subjected to a Restriction Requirement under 35 U.S.C. 121 and 37 CFR 1.141. The Examiner suggests that although the sequences claimed each target and modulate expression of the same gene, the instant antisense sequences are considered to be unrelated, since each antisense sequence is suggested to be structurally and functionally independent and distinct. The Examiner suggests that each antisense sequence has a unique nucleotide sequence and that each sequence targets a different and specific region of human inducible nitric oxide synthase, and each sequence, upon binding to human inducible nitric oxide synthase, functionally modulates the expression of the gene to varying degrees.

Further, the Examiner suggests that a search of more than one (1) of the antisense sequences claimed in claim 3 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search. Applicants have been required to elect one sequence from claim 3.

Applicants respectfully traverse this rejection.

In accordance with MPEP § 803, there are two criteria which must be met for a proper restriction requirement. The first is that the inventions be independent or distinct; the second is that there would be serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

All of the antisense compounds of claim 3 inhibit the expression of human inducible nitric oxide synthase. Thus, Applicants respectfully disagree that the sequences of claim 3 are distinct as being novel and unobvious over each other, as required by MPEP § 802.01.

Further, searching the antisense compositions as set forth in claim 3 does not present a serious burden to the Examiner. A search encompassing compositions which inhibit the expression of human inducible nitric oxide synthase would necessarily reveal prior art references relating to all of the compounds and sequences

at issue. Accordingly, this restriction requirement does not meet both of the criteria required to be proper.

Reconsideration and withdrawal of this restriction requirement is therefore respectfully requested.

However, in an earnest effort to be completely responsive and to facilitate prosecution, Applicants have canceled claim 3. Applicants believe that this amendment is fully responsive to the restriction requirement, and that no election relating to claim 3 is further required.

II. Restriction of the Sequences of Claim 1

The sequences listed in claim 1 have been subjected to a Restriction Requirement under 35 U.S.C. 121 and 37 CFR 1.141. The Examiner suggests that SEQ ID NO: 3 and SEQ ID NO: 17 are patentably distinct because they are unrelated sequences. The Examiner has required the Applicants to elect a single target sequence for examination. Applicants respectfully traverse this requirement.

First as set forth above, the MPEP § 803, requires that two criteria be met for a proper restriction requirement, (a) that the inventions be independent or distinct; and (b) that there would be serious burden on the Examiner if the restriction is not required.

The human inducible nitric oxide synthases of SEQ ID NO:3 and SEQ ID NO:17 are targeted by an antisense compound which hybridizes and inhibits the expression of human inducible nitric oxide synthase. They are clearly related structures. Additionally, there would be no serious burden on the examiner to allow both sequences to remain in claim 1. A search encompassing compositions which inhibit the expression of human inducible nitric oxide synthase would necessarily reveal prior art references relating to both of the sequences at issue. Accordingly, this restriction requirement does not meet either of the criteria required to be proper.

Under MPEP §803.04, it has been determined that normally ten sequences constitute a reasonable number for examination purposes. In contrast, claim 1 recites only two related sequences. As such, the two sequences of claim 1 should not be subject to restriction.

Further, under MPEP §803, if search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. For all of the above recited reasons, Applicants respectfully request reconsideration and withdrawal of the restriction requirement as related to SEQ ID NOs: 3 and 17 of claim 1.

However, in an earnest attempt to be completely responsive and to facilitate prosecution, Applicants elect SEQ ID NO:3 of claim 1, with traverse.

Respectfully submitted,

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